

Attorney Docket No.: DEX-0054
Inventors: Robbins et al.
Serial No.: 09/426,548
Filing Date: October 22, 1999
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REMARKS

Claims 2, 3 and 9 are pending in the instant application. Claims 2 and 3 have been objected to. Claim 9 has been rejected. Claims 2, 3 and 9 have been amended. No new matter has been added by this amendment.

Reconsideration is respectfully requested in light of these amendments and the following remarks.

I. Rejection of Claim 9 under 35 U.S.C. 112, second paragraph

Claim 9 has been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner suggests that there is insufficient antecedent basis for the limitation of "in the sample". Accordingly, in an earnest effort to advance the prosecution of this case, Applicants have amended claim 9 to clarify that the sample is a DNA or RNA sample. Sufficient antecedent basis is provided for a DNA or RNA sample.

Withdrawal of this rejection under 35 U.S.C. 112, second paragraph, is therefore respectfully requested.

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II. Rejection of Claims 9 under 35 U.S.C. 102(b) and 102(e)

Claim 9 stands rejected under 35 U.S.C. 102(b) as being anticipated by Weber et al. and under 35 U.S.C. 102(e) as being anticipated by Liskay et al. The Examiner suggests that unlike the methods set forth in claims 2 and 3 which require binding as an indication of the presence of a given mutant, the product claim of claim 9 has no such requirement, only requiring that it bind any of the given mutants set forth in the claims. The Examiner relies upon the LCR method taught at page 18, lines 14-26 of the specification to suggest that various complimentary primers are used including ones that are complimentary to normal sequences. Thus, the Examiner suggests that because the normal sequence can bind these sequences and the specification and art provides methods for using these sequences in determining the presence or absence of an alteration, the sequence of Weber et al. and Liskay et al. anticipate the claims.

Accordingly, in an earnest effort to advance the prosecution of this case and to further clarify that the oligonucleotide probes of the present invention are specific to mutant, not normal, sequences, Applicants have amended

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claim 9 to specify that binding of the oligonucleotide probe to the DNA or RNA sample occurs only in the presence of a hMLH1 mutant 1, hMSH2 mutant 1, hMSH2 mutant 2, or hMSH2 mutant 3 in the DNA or RNA sample. Support for this amendment is provided in the specification at page 18, lines 23-25 wherein it is taught that hybridization of the probe occurs only when there is full complementarity. Thus, no new matter is added by these amendments.

This amendment clearly distinguishes the present invention from prior art teachings relating to probes to normal sequences wherein binding does not occur only in the presence of the specified mutations. Withdrawal of these rejections under 35 U.S.C. § 102(b) and (e) is therefore respectfully requested.

III. Objection to Claims 2 and 3

Claims 2 and 3 have been objected to as depending upon rejected claim 9. Applicants believe that the above-described amendments to claim 9 overcome all pending rejections to claim 9 and thus overcome the objection to claims 2 and 3 as depending upon a rejected claim. However, in a further effort to facilitate the prosecution of this case, Applicants have also amended claims 2 and 3 to be

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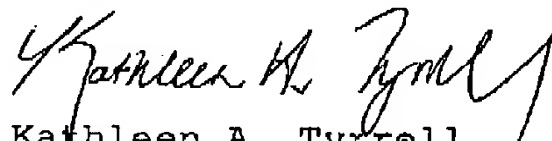
independent.

Withdrawal of this objection to claims 2 and 3 is
therefore respectfully requested.

IV. Conclusion

Applicants believe the foregoing comprises a full and
complete response to the Office Action of record.
Accordingly, favorable reconsideration and subsequent
allowance of the pending claims is earnestly solicited.

Respectfully submitted,



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Date: June 23, 2004

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